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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,264	09/27/2004	Thomas Kreye	KREYE T I PCT	5311
25889	7590	05/17/2006	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			O'HERN, BRENT T	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,264

Applicant(s)

KREYE, THOMAS

Examiner

Brent T. O'Hern

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-35 is/are pending in the application.
- 4a) Of the above claim(s) 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>27 September 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II (claim 35) in the reply filed on 28 April 2006 is acknowledged. Applicant's arguments have been fully considered but are not persuasive. Because applicant did not distinctly and specifically elect with or without traverse, the election has been treated as an **election without traverse** (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made **FINAL**.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. Applicant shall **remove reference numerals and parenthesis** surrounding them.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is vague and indefinite since it does not **positively set forth the limitations** of the claim. The claim should be rewritten using standard U.S. patent claim terminology including where appropriate a preamble and, positive limiting language such as “comprising”, “wherein”, “said”, etc. Furthermore, where the claim sets forth a plurality of elements these elements should be separated by indented lines. (See MPEP 608.01(i) and 703.03(d)).

The phrase “**joined in a non-positive manner**” in line 3 is vague and indefinite because it is unclear what “non-positive” means. It is unclear whether attachment is chemically, mechanically, by a specific type of attachment or whether attachment is optional.

The phrase “**in particular a gasket**” in line 4 is vague and indefinite because it is unclear what “in particular a gasket” is referring to, whether the component is a gasket, whether a gasket is optional or some other meaning.

Examiner's Comment

4. The **numerals and parenthesis** surrounding them in the claims shall be **removed** since they are confusing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1772

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Gross (US 5,088,787).

Gross ('787) teaches a clip-on fastening system (*FIG-1, #15 "molding"*) in which a fastening element that functions as the base part of the clip-on fastening system (*FIG-1, element #23*) is joined in a non-positive manner to a substrate and provides a detachable clip-on fastening of the substrate to a component (*See FIG-1 wherein adhesive #35 joins element #23 to substrate #12*), a gasket (*FIG-1, #17, second member of molding, a gasket*), which is provided with a clip area (*FIG-1, clip area #26*), whereby the fastening element has a cross-sectional shape that corresponds to the clip area of the component (*See FIG-1 wherein the elements clearly fit together.*), wherein a fastening element which has been prefabricated and manufactured using a hard material to produce a hardened continuous profile in an extrusion process is glued to the substrate (*FIG-1 wherein the glue #35 glues the elements together*), and, and the component is clipped onto the finished fastening element (*FIG-1 wherein component #17 is clipped to #23*), and the hard material has a hardness of at least 40 Shore D (*col. 3, ll. 8-9*).


The phrase "**whereby the continuous section is pressed against the substrate when gluing it**" is a **process limitation** in a product claim and hence given little patentable weight since patentability of a product does not depend on its method of production (see MPEP § 2173.05(p)).

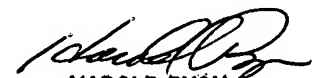
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brent T O'Hern
Examiner
Art Unit 1772
May 9, 2006


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 5/10/06